



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,002	07/18/2003	Shuji Inada	MM4555.	4127
7590 07/31/2006				
Anderson Kill & Olick 1251 Avenue of the Americas New York, NY 10020-1182				
			EXAMINER PUTTLITZ, KARL J	
			ART UNIT 1621	PAPER NUMBER

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,002

Applicant(s)

INADA ET AL.

Examiner

Karl J. Puttlitz

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006 and 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/622518.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The objection to the numbering of the claims is withdrawn since Applicant has renumbered the claims, although these claims should have been designated as new.

The rejection under section 112, first paragraph is withdrawn since upon reconsideration the terms lower condensates is defined by the lower alkyl terephthalates of the specification, which are enabled.

The rejection under section 112, second paragraph is withdrawn since Applicant has amended the claims to remove the term "pre-decomposed" product.

The rejection under section 103 is maintained and repeated below. Applicant's remarks in connection with this ground of rejection is also addressed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06166747 (JP 747) in view of IN 145323.

JP 747 teaches pepolymerisation of aromatic polyesters comprises adding aromatic polyesters to a reaction system containing molten aromatic dicarboxylates and their low polymers, and depolymerising at 200-250 C to make a pre-decomposed product.

Alkylene glycols are charged to the system in amounts of 0.5-5.0 times mole per acid component constituting and thus further depolymerising at 200-250 C and feeding a portion of the aromatic dicarboxylates and their low polymers to a polymerisation system. See attached Abstract.

JP 747 fails to explicitly state that the aromatic dicarboxylate is bis- β -hydroxyethyl terephthalate. However, the invention suggests this compound with the requisite particularity and guidance that bis- β -hydroxyethyl terephthalate would have been obvious to those of ordinary skill as the intended reactant. Moreover, those of ordinary skill would have been motivated to modify the reference to include a step of reacting the pre-decomposed product, or decomposed product with ethylene glycol to obtain the useful monomer, See, for example, IN 145323.

Applicant argues that, based on a conventionally derived calculation, the amount of ethylene glycol is not less than 10.6 times the molar amount of terephthalic acid whereas in JP 747 the content of ethylene glycol in the finally obtained oligomer is not more than 3.3 times the molar amount of terephthalic acid. Applicant also provides detailed calculations to derive this conclusion.

However, this argument is given little weight, since as established above, the combination of the applied references teaches those limitations present in the rejected claims. Applicant's comments do not deny this. Furthermore, the glycol component calculated by applicant in the remarks is not a requirement of the claims, and therefore, is not given any weight. Therefore, the rejection is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at telephone number (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karl J. Puttlitz
Assistant Examiner

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Thurman K. Page
Supervisory Patent Examiner
Art Unit 1621
Technology Center 1600

571-272-0602